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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF FOR RESPONDENT

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BRIEF FOR RESPONDENT

Statement of the Case

In his complaint petitioner alleged (R. 1):

> "(4) The said Hugh W. Sanford, being *the original, first and sole inventor* [1] of improvements in Latch Tripping Mechanisms, duly filed in the United States Patent Office an application for Letters Patent of the United States on said invention, Serial No. 571,170, * * * ."

Therein he prayed (R. 5-6):

> "2. That the Court adjudge that the plaintiff, Hugh W. Sanford, was the *first, true and original inventor* of the said improvements in Latch Tripping Mechanisms, as set forth in his application, Serial No.

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[1] Emphasis is counsel's unless otherwise noted.

571,170 and defined in the counts of Interference No. 82,623, * * *."

Three times the issue of priority has been decided against petitioner—once by the Board of Interference Examiners (R. 3, Par. 9), again by the District Court (R. 15), and still again by the Court of Appeals (R. 18). The District Court, hence, dismissed the complaint, finding it unnecessary to pass upon patentability. The Court of Appeals affirmed.

Those concurrent findings are here unchallenged. Though having here only the status of one who is *not* the first inventor and, hence, as one *not* entitled to a decree in his favor in an action under R.S. §4915 (35 U.S.C. § 63), petitioner nevertheless here presents this question:

> "Should the District Court have decided the issue of patentability, in a suit under Sec. 4915 R.S. on the counts of the Interference, first and foremost, even though the issue of priority be decided in this suit against the plaintiff?"

Thus petitioner whose right to a patent on the counts has been conclusively adjudicated against him, nonetheless here asks this Court to require the patentability of the counts to be determined.

Respondent, Kepner, opposed the granting of the petition for a writ of certiorari upon the ground that the question presented is moot and does not present a controversy under R.S. § 4915 or the Constitution of the United States.

Summary of Argument

Morgan v. *Daniels*, 153 U.S. 120 (1894), was an action under R.S. § 4915. It is decisive against petitioner of the single question here presented. The Court there laid down the now well-known rule as to the weight to be given in

actions under R.S. § 4915 to a decision of the Patent Office on the issue of priority. The Court found against the applicant upon the issue of priority. *Without passing upon patentability* the Court then said (p. 129):

> "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant; and *because of that fact*, and because of *the rule* that controls suits of this kind in the courts,
>
> "We reverse the judgment and remand the case, *with instructions to dismiss the bill.*"

In the case at bar the Courts below did just that.

Morgan v. *Daniels* was the last of a trilogy of cases founded upon R.S. § 4915—*Gandy* v. *Marble*, 122 U.S. 432 (1887), *Hill* v. *Wooster*, 132 U.S. 693 (1890) and *Morgan* v. *Daniels* (1894) that respectively hold:

1. "All the Court that takes cognizance of the bill in equity under § 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law to receive a patent; * * * .'" [*Gandy* v. *Marble*];

2. That if priority is found *in favor of the plaintiff-applicant*, patentability of the claims must be determined and the claims sustained before a judgment can be found for the plaintiff-applicant [*Hill* v. *Wooster*]; and

3. That if priority is found *against the plaintiff-applicant*, the complaint may be dismissed without passing upon patentability of the claims [*Morgan* v. *Daniels*].

Hill v. *Wooster* is without application to a case in which priority is found *against the plaintiff-applicant*, as *Morgan* v. *Daniels* is without application to a case in which priority is found *in favor of the plaintiff-applicant*.

The decisions here relied upon by petitioner as being in conflict with the decisions of the Courts below on the

question here presented, fail to construe *Hill* v. *Wooster* in the light of the facts with respect to which it was decided and reveal no awareness that that question was settled in the negative by *Morgan* v. *Daniels*.

Even if the usual "better practice" doctrine in patent infringement suits, as stated in *Sinclair & Carroll Co. Inc.* v. *Inter Chemical Corp.*, 325 U.S. 327, 330, were applicable to actions under R.S. § 4915, that doctrine is not mandatory and its nonuse by the Courts below was not error.

No actual controversy now exists between the parties with the consequence that petitioner is without right to demand that patentability of the claims be adjudicated and this Court is without jurisdiction under R.S. 4915 or the Constitution to hear his demand or order such adjudication.

Argument

I

MORGAN v. *DANIELS*, 153 U.S. 120 (1894) ESTABLISHES THAT THE COURTS BELOW DID NOT ERR IN FIRST RESOLVING THE ISSUE OF PRIORITY AND, HAVING FOUND PLAINTIFF-APPLICANT WAS NOT THE FIRST INVENTOR, IN DISMISSING THE COMPLAINT WITHOUT PASSING UPON PATENTABILITY OF THE COUNTS

A. The Holding of Morgan v. *Daniels*

Only the question specifically brought forward by the petitioner for the writ of certiorari is here to be considered. Rule 38, Par. 2; *General Pictures Co.* v. *Electric Co.*, 304 U.S. 177-179; *Helvering* v. *Taylor*, 293 U.S. 507, 511.

To that question *Morgan* v. *Daniels* answers that the Courts below did not err in holding that the trial Court may first determine priority and, if that is found against the plaintiff-applicant, the complaint may be dismissed without passing upon patentability.

R. S. § 4915 as it stood before the Court in *Morgan* v. *Daniels* is quoted in the report of that decision, 153 U.S. 120 at page 121, as follows:

> " 'Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled, according to law, to receive a patent for his invention,* as specified in his claim, or for any part thereof, *as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent* on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.' "

As far as here pertinent, the statutes here and there involved are identical, the present R.S. §4915 reading as follows:

> "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled, according to law,*

> *to receive a patent for his invention,* as specified in his claim or for any part thereof, *as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent* on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. * * *"

In *Morgan* v. *Daniels* priority was awarded in the Patent Office to Morgan. Thereupon, Daniels brought an action under R.S. §4915. In his complaint he alleged, as did Sanford in his complaint in the action at bar, "that he was the original, sole and first inventor of * * *" the subject matter of the claims in issue. The Circuit Court found Daniels to be the first inventor and without passing upon patentability of the claims involved, concluded:—

> "A decree will be made, authorizing the issue of the patent to the complainant as prayed." (*Daniels* v. *Morgan* (C.C. Mass.), 42 Fed. 451 (May 29, 1890).

Upon appeal by Morgan to this Court the evidence upon priority was reviewed, and the Court held (p. 125):—

> "Upon principle and authority, therefore, it must be laid down as *a rule* that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

Without a single reference to the patentability of the claims, this Court concluded with these words (p. 129):

> "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in

awarding priority of invention to the defendant; and *because of that fact*, and because of *the rule* that control suits of this kind in the courts,

"We reverse the judgment and remand the case, *with instructions to dismiss the bill.*"

This is precisely what the Courts below did in the case at bar.

Hill v. *Wooster*, 132 U. S. 693, was decided by this Court January 13, 1890, some four years before the decision in *Morgan* v. *Daniels*. The same statute was involved in each case. In each case the judgment of the Trial Court was in favor of the plaintiff-applicant. In each case the judgment of the Trial Court in favor of the plaintiff rested *solely* on the finding that the plaintiff was the prior inventor. *Hill* v. *Wooster* accepted the finding of the Trial Court favorable to the plaintiff-applicant on the question of priority and after quoting R.S. §4915, said (p. 698):—

"It necessarily follows that no adjudication can be made *in favor of the applicant*, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, *in favor of the applicant*, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved."

As stated above in *Hill* v. *Wooster*, the obligation to determine patentability, if the plaintiff is to prevail, is derived from the sanction given by the Court to the patent which it authorizes under the terms of the statute. *Hill* v. *Wooster* did not hold, nor did it intimate, that this rule should ap-

ply when the lower Court authorized no patent, and thus sanctioned nothing. It did not determine what obligation was upon the lower Court in the event the defendant prevailed on priority. *Hill* v. *Wooster*, therefore, imposes no obligation upon the lower Court to determine patentability in the event that the plaintiff does not prevail on priority. That there is no obligation under such circumstances was conclusively established four years later by *Morgan* v. *Daniels*, wherein this Court dismissed a bill under R.S. § 4915 on a finding adverse to the plaintiff solely on the issue of priority.

As stated in *St. clair* v. *United States*, 279 U. S. 749, 767, it is a fundamental principle that:

> "Always the language used in an opinion must be read in the light of the issues presented."

In *Safe Deposit & T. Co.* v. *Virginia*, 280 U. S. 83, 94 this Court after referring to some previous opinions stated the principle thus:—

> "Any general statement in the above opinions which may seem to interfere with the conclusion here announced must be limited and confined to the precise situation then under consideration."

Applying this principle, it becomes manifest that *Hill* v. *Wooster* is without application to a case in which priority is found *against the plaintiff*, as *Morgan* v. *Daniels* is without application to a case in which priority is found in *favor of the plaintiff*. Neither bars a decision on patentability in any case. However, neither *Hill* v. *Wooster* nor *Morgan* v. *Daniels* requires that patentability be decided "first and foremost",[2] or at all, if priority is not established by the plaintiff.

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[2] To require a trial court to determine any issue "first and foremost" would transgress its discretionary powers under Rule 42(b) of the Federal Rules of Civil Procedure.

B. The Decisions Below Followed Exactly the Pattern and Procedure Adopted by This Court in Morgan v. Daniels

The District Court in this case (R. 7):

> "took its position with the line of cases that holds that in a 4915 action patentability need not be considered where the claimed priority is not established, and, by the same token, when the one seeking the decree under 35 U.S.C. 63 prevails in the Trial Court upon the question of priority, the patentability of his claim must be decided."

In affirming the District Court, the Court of Appeals said (R. 20):—

> "But nothing in section 4915 or *Hill* v. *Wooster* can be taken as requiring the District Court to incorporate in a judgment dismissing applicant's claim of priority of invention an adjudication as to the defendant's entitlement to letters patent."

Then, after quoting from *Hoover Co.* v. *Coe*, 325 U. S. 79 (1945), the Court concluded (R. 21):

> "We think the foregoing language suggests at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority of invention."

Recognizing a privilege to decide patentability but construing *Hill* v. *Wooster* as having no application to an action in which priority is determined adversely to the plaintiff, the courts below dismissed the complaint without passing upon patentability. They followed exactly the pattern and result adopted by this Court in *Morgan* v. *Daniels* under identical circumstances. *Morgan* v. *Daniels* is therefore controlling and, it is submitted, requires affirmance of the Court below.

Since *Hill* v. *Wooster* and *Morgan* v. *Daniels*, there have been numerous decisions of courts of appeals involving the determination of patentability in interference actions under R. § 4915. The majority of these decisions, along with those of the Courts below, hold the mandate of *Hill* v. *Wooster* on patentability to be non-existent if the plaintiff is defeated on other grounds. Exemplary of such decisions are the following: *Smith* v. *Carter Carburetor* (C. C. A. 3), 130 F. 2d. 555; *Texas Co.* v. *McAfee* (C. C. A. 5), 299 Fed. 718; *Smith* v. *Prutton* (C. C. A. 6), 127 F. 2d. 79; *Cleveland Trust Co.* v. *Berry* (C. C. A. 6), 99 F. 2d. 517; *Heston* v. *Kahlke* (C. C. A. 6), 179 F. 2d. 222; *Philadelphia Storage Battery Co.* v. *Zenith Radio Corp.* (C. C. A. 7), 117 F. 2d. 642; *Boucher Inventions* v. *Sola Electric Co.* (C. A. D. C.) 131 F. 2d 225, cert. den. 318 U. S. 770; *Muther* v. *United Shoe Machinery Corp.* (D.C. N.J.), 7 F. 2d. 954.

Some cases, such as the three relied upon by Petitioner, *Knutson* v. *Gallsworthy*, (C. A. D. C.), 164 F. 2d. 497; *Triplett* v. *Line Material Co.*, (C. C. A. 7), 133 F. 2d. 533 and *Minneapolis Honeywell* v. *Milwaukee Gas Co.*, (C. C. A. 7), 174 F. 2d. 263, contain language which would indicate that a mandate for determining patentability is imposed upon the Trial Court, whether or not the plaintiff prevails on priority. As earlier pointed out, under *Hill* v. *Wooster* and *Morgan* v. *Daniels*, a Trial Court is privileged to determine either priority or patentability, or both, but has a mandate on patentability only in cases in which the plaintiff has prevailed on priority. On this basis, there is little inconsistency in the actual holdings of Courts of Appeals, and the statements in the three cases relied upon by Petitioner, which purport to extend the rule of *Hill* v. *Wooster* beyond its facts, are merely dicta.

Two of these three cases, *Knutson* and *Minneapolis*

Honeywell, were the same in their facts as *Hill* v. *Wooster* and the Court of Appeals in each case obtained the same result. Thus, in the *Knutson* case in which several actions involving related counts had been joined, the Trial Court found priority for a plaintiff as to one of the counts, making the determination of patentability mandatory, as held the Court of Appeals. In the *Minneapolis Honeywell* case the Trial Court adjudged the plaintiff entitled to a patent, requiring it, as it did, to determine both priority and patentability. The *Triplett* case is different in its facts from the other two. There the defendant raised the issue of patentability and the Trial Court dismissed the bill on a finding adverse to the plaintiff on this issue. It thus exercised its privilege to rest its decision on either ground, priority or patentability, which would defeat the plaintiff's suit. As opposed to their actual holdings, the inconsistent language of these cases requires no discussion since it shows a complete unawareness that this Court in *Morgan* v. *Daniels* had long since determined the inapplicability of the mandate of *Hill* v. *Wooster* to a case where the plaintiff had not prevailed on priority.

The fallacy in the dicta of the above cases is pointed out by Judge Simons in the *Heston* case wherein he said (Page 227 of 179 F. 2d.):

> "It has undoubtedly sometimes been thought, perhaps without too careful consideration of the precise language of Hill *v.* Wooster, supra, that it is the duty of the court in all circumstances to consider the question of validity, as in Palmer Pneumatic Tire Co. *v.* Lozier, 6 Cir., 90 F. 732, where it was declared that the power of the court should not be 'perverted to the determination of an unprofitable inquest as to who was the first discoverer of a nullity.' The seeming eloquence of this observation may, with equal logic, be met by the view that a court *should not be perverted*

by efforts to make a nullity of that which one has sought as a thing of value. As Judge Allen observed in the *Berry* case, Hill *v.* Wooster does not justify broadening of the issues under Section § 4915 at the instance of one who may not receive a patent so as to make it the 'practical equivalent of an infringement suit in which all the defenses known to the patent law may be brought forward.' (99 F. 2d: 522)."

C. There is No Basis in the Derivation of R.S. § 4915 or in Hoover v. Coe, 325 U.S. 79, for a Different Result Than Was Obtained in Morgan v. Daniels and the Courts Below

Petitioner in his brief endeavors to establish by reference to the Patent Acts of 1836 and 1870 a duty on the Trial Court to determine patentability in all interference actions under R.S. 4915 and a recognition of that duty by this Court in *Hoover Co.* v. *Coe*, 325 U.S. 79. Petitioner's contention, in short, is that Section 16 of the Patent Act of 1836 (Petitioner's App. 17) imposed on the Trial Court in an interference action the obligation to determine either priority or patentability and that the change in language with reference to interference actions in Section 52 of the Consolidated Patent Act of 1870 (Petitioner's App. 18) and a carry-over of the latter language to R.S. § 4915, showed the intent of Congress to make the determination of both issues mandatory. This interpretation Petitioner predicates on the terminology of the several Acts as to the basis on which judgment shall be rendered. In the Act of 1836 it is: "as the fact of priority of right or invention shall in any such case be made to appear". The corresponding provision in both the Act of 1870 and R.S. § 4915 reads: "as the facts in the case may appear". The change of "fact" in the earliest Act to "facts" in the later Acts,

petitioner asserts, shows the intent of Congress that the obligation shall be joint.

Petitioner, of course, presumes that the language of the later Acts means "facts of priority and invention" and he relies heavily on footnote 29 to *Hoover* v. *Coe*, 325 U.S. 79, 90, as so establishing. But this footnote has reference to the interfering patent portion of Section 16 of the Act of 1836 which is now covered by R.S. § 4918, 35 U.S.C. 66, and has no pertinency to R.S. § 4915.

As to the decision, itself, *Hoover* v. *Coe* was an *ex parte* action concerned with what Patent Office rulings were reviewable under R.S. § 4915. As pointed out by Mr. Justice Roberts in the body of his opinion, *Hill* v. *Wooster* "did not purport to decide" that issue and was therefore inapplicable. Nor did *Hoover* v. *Coe* purport to change *Hill* v. *Wooster*. Instead, as recognized in *Knutson* v. *Gallsworthy*, 164 F. 2d 497, 500, it "left the rule of Hill v. Wooster, supra, intact".

Further discussion of the vagaries of statutory interpretation into which petitioner would lead this Court is rendered wholly unnecessary by *Morgan* v. *Daniels*. That case was decided in 1894 and under a version of R.S. § 4915 which, in the language here pertinent, is identical with the present Act. By ordering dismissal of the bill solely on an adjudication adverse to the plaintiff on priority, without even considering patentability, this Court conclusively established that R.S. § 4915 imposes no duty on a Trial Court to determine patentability when the plaintiff has failed to established priority.

As to Congressional intent, it is a settled rule of statutory construction that where a statute or a portion thereof has been construed by a Court of last resort and the same is subsequently re-enacted, the Legislature must be considered to have adopted that construction. *Electric Bat-*

tery Co. v. *Shimadzu*, 307 U. S. 5, 14; *Sessions* v. *Romadka*, 145 U. S. 29, 41, 42; *Manhattan Prop.* v. *Irving Tr. Co.*, 291 U. S. 320, 336; *United States* v. *Elgin, J. & E. Ry.*, 298 U. S. 492, 500; *United States* v. *Ryan*, 284 U. S. 167.

Section 4915 of the Revised Statutes became law on June 22, 1874. It was amended on Feb. 9, 1893 by Sec. 9, c. 74, 27 Stat. 436; on March 2, 1927 by Sec. 11 of c. 273, 44 Stat. 1336; on March 2, 1929 by Sec. 2(b), c. 488, 45 Stat. 1476; and on August 5, 1939 by Sec. 4 of c. 451, 53 Stat. 1212.

Notwithstanding the several amendments, R.S. § 4915 has at all times contained the provision here pertinent that "the court having cognizance thereof * * * may adjudge that such applicant is entitled according to law to receive a patent for his invention, as specified in his claim or for any part thereof, *as the facts in the case may appear.* And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements".

Morgan v. *Daniels* having been decided by this Court in 1894, its construction of R. S. 4915 must be regarded as having been adopted by Congress not once, but three times.

II

PETITIONER HAS NO RIGHT TO A DETERMINATION EITHER OF THE QUESTION PRESENTED OR OF THE PATENTABILITY OF THE COUNTS.

Should this Court reverse the Court of Appeals as petitioner prays, it would make mandatory the determination of patentability in *all* interference proceedings under R. S. § 4915 and preclude the Trial Court from dismissing the complaint on a finding of priority adverse to the plaintiff. This, as has been shown, would conflict directly with *Morgan* v. *Daniels*, supra.

A reversal would also apply to actions under R.S. § 4915, a harsher rule than has sometimes been invoked in patent infringement suits under the so-called "better practice" doctrine. As that doctrine was stated by this Court in *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U. S. 327, 330, it is not mandatory but "usually the better practice" in infringement suits to determine the question of validity. In a patent infringement suit a sharp contest as to the validity of the claims can be expected. No such contest as to patentability ordinarily can be expected in a 4915 action in which both parties want the counts. Thus, even to apply the "better practice" doctrine to 4915 actions would unduly burden the Trial Court and to impose a mandate to decide patentability in all cases would be insufferable. As pointed out by Judge Leahy in a footnote to *Shell Development Co.* v. *Universal Products Co.*, (D. C. Del. 1945), 61 F. Supp. 925, 927, the Trial Court would then find itself in this dilemma:

> "In a 4915 proceeding both parties want the patent, neither would suggest questions of invalidity. The requirement that this Court must pass on validity removes this particular issue from without the adversary system. The Court, itself, must research through the prior art, be its own expert, become advocate for the government (but not for the Patent Office, which was of opinion validity existed) vis-a-vis both plaintiff and defendant. Perhaps the appointment of an advisory Master—for which there is no statutory authority—but on the basis of an exercise of the Chancellor's traditional powers—whose function will be to test validity at sword's length with both plaintiff and defendant, will meet the usual inability of the district judge to stop his business of judging to become an expert in many arts."

A reversal would do more. In the case at bar petitioner could have preserved the question of priority of invention

by including it in his petition to this Court. He deliberately chose not to do so. He thus stands finally adjudged not to be the first inventor of the counts. *Helvering* v. *Taylor,* 293 U. S. 507, 511; *Helis* v. *Ward,* 308 U. S. 365, 370. And a person who is not the first inventor is not entitled to a patent. *Milburn* v. *Davis-Bournonville Co.,* 270 U. S. 390, 402. So, petitioner having finally disclaimed prior inventorship, has no right to a patent on the counts.

To reverse the Court below, under these circumstances, and permit petitioner now to contest the patentability of the counts, would be a clear precedent for the loser, in an interference proceeding in the Patent Office, to convert a 4915 action into a trial of patentability of claims to which he makes no pretense of right. The advantage given to a claimant, intially bona fide, who finds at the Patent Office stage that he cannot establish priority is evident. Equally apparent is the opportunity afforded a fraudulent claimant to harass the holder of a recently issued patent.

But no such perversion of R.S. § 4915 was intended by this Court. Instead, it held in *Gandy* v. *Marble* that the only case or controversy determinable under R.S. § 4915 was whether the plaintiff-applicant was entitled to a patent. As there stated, (p. 440 of 122 U. S.):

> "All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

That R.S. § 4915 confers upon a court only limited statutory powers was again recognized in *Illingworth* v. *Atha,*

42 Fed. 141 (C. C. D. N. J., 1890) at 144 wherein Judge Green said:

> "This is purely a statutory proceeding, and the court cannot go outside the statute which is the foundation of the action to assume to itself powers not found in the purview of the act. The section under consideration has but a single object—to provide a way by which an unsuccessful applicant for letters patent, notwithstanding the rejection of his claim by the commissioner of patent, may obtain them through an adjudication, in favor of his right thereto, by a court of equity having cognizance of the subject matter; and, as the object of the section is single, so is the power of the court plainly limited under it to the accomplishment of that object. The prayer of a bill of complaint exhibited to the court under and by virtue of this section would be for a decree that the complainant has established his right to have letters patent issued to him. So far may the decree of the court go, but no further. It may adjudge an issue of the letters, or it may declare the complainant to be without right. In either case the power conferred by this section is exhausted."

Finally adjudicated not to be the first inventor of the subject matter of the counts and thus not entitled to a patent, petitioner now has no case or controversy under R. S. § 4915 as construed by *Gandy* v. *Marble*, supra. Yet, as set forth in his brief, petitioner here relies for jurisdiction solely upon that statute. Petitioner now having no standing under R.S. § 4915, it inevitably follows that his failure to preserve his claim of right to a patent deprived this Court of jurisdiction to determine the "question presented".

Whether a case or controversy was non-existent initially or became so pending appeal or review matters not. The result is the same. The Court is deprived of jurisdiction and the case must be dismissed. *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992; *United States* v. *Munsing-*

wear, 340 U. S. 36, 39, 95 L. Ed. 36, 41; *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294. And, except as to costs, it makes no difference that the event occurred, as here, by Petitioner's own act and without fault of the Respondent. *Heitmuller* v. *Stokes*, supra.

As said in *Mills* v. *Green*, supra:—

> "The duty of this court, as of every other judicial tribunal, is to decide actual controversies by a judgment which can be carried into effect, and not to give opinions upon moot questions or abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it. It necessarily follows that when, pending an appeal from the judgment of a lower court, and without any fault of the defendant, an event occurs which renders it impossible for this court, if it should decide the case in favor of the plaintiff, to grant him any effectual relief, whatever, the court will not proceed to a formal judgment, but will dismiss the appeal. And such a fact, when not appearing on the record, may be proved by extrinsic evidence: Lord v. Veazie, 8 How. 251, 12 L. Ed. 1067; California v. San Pablo & T. R. Co., 149 U. S. 308, 37 L. Ed. 747, 13 Sup. Ct. Rep. 876". See also United States v. Hamburg-Amerikanische Packet-fahrt-Actien Gesselschaft, 239 U. S. 466, 476, 60, L. Ed. 387, 391, 36 Sup. Ct. Rep. 212, and cases cited.

Even had *Gandy* v. *Marble* never been decided, petitioner would have no case or controversy cognizable by this Court under the circumstances here present. He has disclaimed any right to a patent on the counts and asserts no aggrievement from the holder of the Kepner Patent No. 2,487,447 in which those counts are contained as claims. He is therefore a complete stranger to the Kepner patent and has no more right than another such stranger to con-

test its validity. *Aralac, Inc.*, v. *Hat Corporation of America* (C. C. A. 3), 166 F. 2d. 286.

Conclusion

The Order granting the Petition for Writ of Certiorari should be vacated and the Writ denied; or, if Petitioner has a right to a review of the judgment below, it should be affirmed.

Respectfully submitted,

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